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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,001	09/16/2003	Martin Schmidt	GMH/409/US	1748
2543	7590	10/11/2005	EXAMINER	
ALIX YALE & RISTAS LLP 750 MAIN STREET SUITE 1400 HARTFORD, CT 06103			NGUYEN, THONG Q	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/663,001

Applicant(s)

SCHMIDT ET AL.

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/16/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Drawings*

2. The drawings contained two sheets of figures 1-3 were received on 9/16/03.

These drawings are objected by the Examiner for the following reason(s).

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

First, the feature related to the hook-like or undercut actuating element extending from a base as recited in each of claims 11 and 16;

Second, the actuating member movable in two perpendicular directions and having six corresponding switching functions as recited in claim 13;

Third, a carrier system comprises at least one motor as recited in claim 17; and

Fourth, the connection among the switch, the actuator and the motor as recited in claim 19. Applicant should note that the figures just show a connection between the switch and the electric supply unit by either a cable (figures 1-2) or a wireless connection (figure 3). The figures do not show the connection among the switch, the actuator and the motor.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Specification***

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

First, the specification does not provide a support for the feature related to a carrier system comprising at least one motor as recited in claim 17. Applicant is respectfully invited to review the specification, in particular, page 5. In particular, page 5 of the specification discloses a microscope (11) equipped with motors (31) for the rotary movement (13) and focusing purposes. The carrier system (14) supports an electric supply unit (15) electrically connection to the motors. The specification has never disclosed that the carrier system has at least one motor as claimed.

Second, the specification does not provide support for the feature related to the connection among the switch, the actuator of the microscope and the motor as recited in claim 19. The specification as disclosed states that the movement of the microscope is made by the motors (31) which is electrically connected to the electric supply unit (15) disposed on the carrier system (14). The switch (16) is connected to the electric supply unit via a cable or a wireless connection. The specification has never disclosed that the switch is connected to the motors (31) and the motor (if any?) of the carrier system.

### ***Claim Objections***

6. Claims 3-6 and 8 are objected to because of the following informalities.

Appropriate correction is required.

a) In each of claims 3-6, the claim recites a connection between the switch and the drive element or the supply unit. However, since the base claim 1 does not disclose a supply unit and thus the feature "the supply unit" recited in each of the

mentioned claims lacks a proper antecedent basis. Should the mentioned feature be changed to --a supply unit-- to make each of claims 3-6 comply with the requirement of 35 USC 112, second paragraph?

b) Claim 8 is objected to because the feature "said devices" recited on lines 1-2 lacks a proper antecedent basis. Applicant should note that claim 2, not claim 1, provides a proper antecedent basis for the mentioned feature. It is suggested that the claim either should be canceled or be amended to add feature of claim 2 into the claim 8. Applicant should also noted that the claim 8 should not be amended to depend upon claim 2 or claim 4 since each of claim 7 and claim 9 recited the same features is already dependent upon claim 2.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, 11-13, 16-17 and 19, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al (U.S. Patent No. 4,912,388) in view of Furukawa (Japanese reference No. 2002-125219, hereafter JP'219).

Tanaka et al discloses an operating-microscope. The microscope as described in columns 1-3 and shown in fig. 2(A) comprises a microscope (5), a carrier system (1-4) for supporting an moving the microscope in a plurality of directions and rotation. One drive element (4) located in the carrier system is sued for moving

the microscope in X-Y directions as can be seen in column 1 and fig. 2(A), arrows (B, C) and another drive element for moving the microscope for focusing. See figure 2(A), element D. In order to activation the carrier system and its driving elements, Tanaka et al disclose the use of a switch system which is connected to the carrier system via a cable. See columns 1-3 and fig. 2(A), element 6. The switch board comprises a base for supporting a plurality of switching elements wherein each switching element, when activated, will provide a particular function to the operation of the microscope such as zooming (element 9), focusing (element 10). It is noted that each switching element has a hook-like or undercut configuration and extends from the base. Regarding to the shape of each switching element, it is obvious to one skilled in the art to utilize any kind of shape including a mushroom shape for the switching element for the purpose of providing a more convenient to the user during an operation thereof. Regarding to the feature that the switching board is sterilizeable, it is noted that such feature is known to one skilled in the art since a user of the microscope provided by Tanaka et al will routine to carry out a sterilization of the switch board and other components of the microscopes for the purpose of maintaining a clearness status for an incoming operation. Regarding to the position of the switch board, it is noted that the switch board can be used as a foot switch (see column 1-3 and fig. 2(A)) or a hand switch (see column 8 and figs. 8). As a result, the microscope with a switch board for controlling the microscopic functions as provided by Tanaka et al meets all of the features recited in the present claims

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except the feature that the switch board is arranged on an operating table as claimed.

However, the arrangement of a switch board on an operating table is known to one skilled in the art as can be seen in the system provided by Furukawa. In particular, Furukawa discloses an optical system having a microscope, a set of endoscopes, a control system and the connection among those mentioned elements and teach an arrangement of a switch board (26) on the operative table (2). See column 3, section [0015] and fig. 1. It is within the level of one skilled in the art that the connection of the switch board to the operative table is able to make in a removably connection via a mechanism which permits the movements of the switch board with respect to the operative table so that a user can easy operate the switch board.

Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the microscope system having a foot(or hand) switch board as provided by Tanaka et al by arranging the switch board on the operative table as suggested by Furukawa so that the user can actuate the switch with more easier and accuracy.

9. Claims 5-6, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al in view of Furukawa as applied to claims 1-2 above, and further in view of Sugino (Japanese reference No. 9-47459, hereafter JP'459).

The combined product as provided by Tanaka et al and Furukawa does not disclose that the connection between the switch and the driving element of the



system is a wireless connection. However, such use of a wireless connection as claimed is merely that of a preferred embodiment and no criticality has been disclosed. The support for that conclusion is found in the specification in which the applicant has admitted that the connection between the switch and the drive member is a cable. It is also noted that the use of a cable for connection between the switch and the drive member is indeed claimed as can be seen in present claims 3-4. Further, the use of a wireless connection in place of a cable is known to one skilled in the art as can be seen in the microscope provided by Sugino. See sections [0012]-[0020] and figs. 1, 6 and 8. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined product provided by Tanaka et al and Furukawa by using a wireless connection between a switch system and a drive member in stead of cable as suggested by Sugino for the purpose of avoid the cable which might cause the disadvantages to the user during an operation and also eliminating the process of sterilization the cable.

10. Claims 7-10, 14-15, 18 and 20, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al in view of Furukawa as applied to claims 1-4, 11, 13 and 17 above, and further in view of Putman (U.S. Patent No. 5,597,146).

The combined product as provided by Tanaka et al and Furukawa does not clearly disclose the mechanism for removably connecting the switch board to the operative table. However, the use of a mechanism having a clamp and a

connection between the clamp and the equipment is known to one skilled in the art as can be seen in the system provided by Putman. In particular, in column 6 and shown in figures 1, 3-4. Putman discloses the use of a mechanism having a clamp (18) and a connection (20) made by tubes/rods connected by joints so that the mechanism is able to connect an optical device (16) to an operative table (12). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the connection between the switch board and the operative table as provided in the combined product of Tanaka et al and Furukawa by utilizing the mechanism having a clamp and a connecting system as suggested by Putman for the purpose of providing of connecting the switch board to the table which offers means for movements of the switch board with respect to the table.

### ***Conclusion***

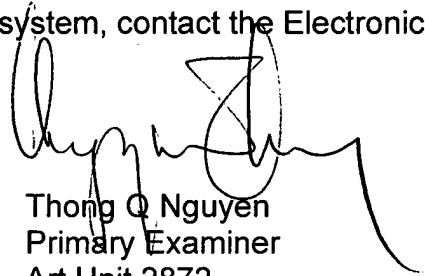
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional U.S. Patents are cited as of interest in that each discloses an optical system having an optical device and an operating table wherein a control console is attached to the operating table.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen  
Primary Examiner  
Art Unit 2872

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